

### **REMARKS**

Reconsideration and allowance of the captioned application in view of the following remarks are respectfully requested. The claims in the application are claims 1 – 25.

At the outset, it is noted that a restriction requirement under 35 US 121 has been lodged. As requested in the office action, the undersigned affirms the election of group I, claims 1 –22. However, the applicants traverse this restriction requirement. More specifically, it is noted that each of groups I, II, and III state that the subject matter therein is classified in “class 424, subclass 401,70.17 for example”. That is to say, the area for searching for each of the three groups has been indicated so far to be the same. Under MPEP Section 803 on page 800-4, it is stated that if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits even though it claims inventions which are independent and distinct. In the present case since the three groups namely, group I which is directed to a composition, group II which is directed to a method for treating hair and group III which is directed to a method for treating skin all have the same search area, a search of the entire set of claims in this application would be without serious burden and therefore examination of all 25 of the pending claims is respectfully requested.

Claims 1-22 have been rejected under 35 USC 103 (a) as being unpatentable over Reid. This rejection is respectfully traversed. More specifically, page 4 last 8 lines of the office action state that the nonionic surfactants suitable for use in Reid are condensation products of aliphatic C8-C18 primary or secondary linear or branch chained alcohols or phenols with alkaline oxides, usually ethylene oxide and generally 6-30 EO. Indeed, Reid at column 2, lines 43-53 make this very statement. However, it

is noted that in the present claims the nonionic surfactant that is employed is stated to be an alkoxyated nonionic surfactant, the alkoxyated nonionic surfactant not being an alkoxyated fatty alcohol containing 6 to 30 ethylene oxide groups. In other words, the nonionic co-surfactants present in the compositions of the instant invention specifically exclude nonionic surfactants with the degree of ethoxylation recited in the Reid patent. MPEP section 2143.03 states that for their to be a proper obviousness rejection all claim limitations must be taught or suggested. Here, the teaching of a nonionic cosurfactant with a degree of ethoxylation outside the range of 6-30 is not taught or suggested by Reid. MPEP section 2144.05 at page 2100-134 states that a prima-facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. In response to this teaching from the MPEP and from the case law the applicants would point out that in the present claims precisely the range of ethoxylation, is being excluded that is generally being recommended in the Reid patent. Therefore, if anything, the Reid patent teaches away from the claimed compositions. Applicants could find no other general discussion of ethoxylated nonionic surfactants in the Reid patent. In example 1, at column 5, lines 20-45, there is presented a shampoo which comprises a silicone oil, said oil having 2% of lauryl alcohol ethoxlate 2 EO and 2% lauryl ethoxylate 21EO. Therefore, this example 1 includes, in the silicone oil portion, 21 EO nonionic cosurfactant which is explicitly excluded by the present claims. Applicants were unable to find any other specific examples of ethoxylated nonionic co-surfactants in Reid. Moreover, examples 1 –4 on pages 13 through 17 of the present specification all show that when a nonionic cosurfactant with 5 EO or less is employed significantly higher depositions of silicon on hair occurs. This is neither disclosed nor suggested by Reid.

The office action itself at page 5 states that Reid does not teach the particular percentages of cosurfactant employed in the present claims. However, the office action

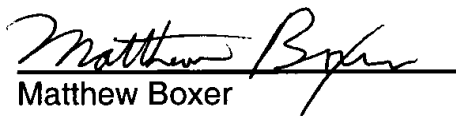
asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ co-surfactants in the percentages claimed, the motivation being optimization of amounts within the shampoo compositions. This statement is respectfully traversed. MPEP at section 2144.05 page 2100-134, cites the case of *In re Aller*, 105 USPQ 233, 235 for the proposition that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. However, the *Aller* case itself states that in a process, while normally a change in concentration or temperature would be an unpatentable modification, that under some circumstances such changes may impart patentability if the ranges claimed produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. Here, the specific percentages of co-surfactants employed result in a difference in kind and not merely in degree with respect to the claimed compositions. More specifically, use of the nonionic co-surfactants in the percentages claimed results in a significantly higher silicon deposition. By contrast, applicants were unable to find such teaching with respect to percentages of nonionic surfactant in the Reid patent. It is noted that in the examples for example at page 16 of the specification the applicants are talking about silicon deposition. That is to say the applicants are talking about the amount of elemental silicone (see col. 1, lines 32-36 of Reid) that is deposited on the hair. By contrast, Reid has only generalizations about depositions of silicones (see column 1, lines 32-36 of Reid) and none which relate to specific amounts of nonionic co-surfactants.

Finally, independent claim 2 on page 19, lines 15-30 of the present specification is even further removed from Reid in containing a recitation that the premix of components a), b) and c) in water at a 1 to 10 ratio of premix to water forms a turbid mixture. Applicants were unable to find any disclosure or suggestion of this turbidity of the premix in the Reid patent.

For the above reasons, it is respectfully submitted that the present claims are patentable over the cited patent and therefore an early notification of allowance is respectfully requested.

If a telephone conversation would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,

  
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